UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,770	06/23/2003	Shenshen Wu	20002.0249A	5720

23517 7590 12/23/2004

SWIDLER BERLIN SHEREFF FRIEDMAN, LLP
3000 K STREET, NW
BOX IP
WASHINGTON, DC 20007

EXAMINER	
BUTTNER, DAVID J	

ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/600,770	WU, SHENSHEN	
	Examiner	Art Unit	
	David Buttner	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 2/3/04
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The status of the parent applications must be updated if/when status changes.

The "dimers" of claims 10-18 do not have basis in 9-466434. The effective filing date for these claims is 7/15/02.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"low free" in claims 1,2 and 8 is not understood. The examiner cannot find a definition in the specification.

It appears claim 9 does not further limit claim 1. Claim 9 describes some golf ball structure, yet the claims 9 and 1 are directed to compositions.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rosthauser '490.

Rosthauser exemplifies (#7) a polyurethane of PTMEG, hexamethylene diisocyanate and butanediol. This is applicant's preferred combination of monomers. Applicant's "for golf balls" is merely a future intended use. Inherently, Rosthauser's material could be used in/on a golf ball.

Claims 1,3-6 and 9 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wu '974.

Wu discloses golf ball covers of urethanes (abstract). The polyurethane results from a urethane prepolymer and a curing agent (col 4 line 19). The prepolymer can be based on methylene bis(cyclohexylisocyanate) (col 4 line 33). The curing agent can be trimethylol propane (col 4 line 36). Use both simultaneously would be obvious if not considered anticipated.

Claims 15-18 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rosenberg 2003/0203771.

Rosenberg teaches covers for golf balls made of urethane prepolymer reacted with chain extender (abstract). The chain extender can be butanediol (paragraph 53). This qualifies as applicant's curing agent. The prepolymer can be based on a dimerized

fatty acid polyester (paragraph 39). The diisocyanate can be HMDI (paragraph 34). Even if the number of choices of monomers are too large to be considered anticipatory, the claims are considered obvious as all applicant's limitations are suggested by the reference.

Claims 10-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenberg 2003/0203771 in view of Sullivan 2002/0045696.

Rosenberg does not suggest a third layer in his golf ball.

Sullivan teaches dual cores and inner cover layers beneath urethane covers. The multilayered configuration improves distance (abstract). It would have been obvious to include at least one additional layer in Rosenberg's ball for the expected advantages.

Claims 15-18 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP02064174.

The reference prepares inks from fatty acid dimerized polyesterpolyols, isophorone diisocyanate, butane diol and diamine. Applicant's "for golf ball" is merely a future intended use. Inherently, the reference's ink could be used on a golf ball even if the author does not recognize the possibility.

Claims 1-9 and 15-18 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sarpeshkar '810.

Sharpeshkar exemplifies polyurethane prepolymers of hexamethylene diisocyanate or methylene bis(cyclohexyl isocyanate) with polyetherols or polyesterols. This prepolymer is then reacted with a diol such as hexane diol (#37). The polyesterol can be based on dimeric fatty acids (col 3 line 25). Inherently, this urethane has the

capability to be used in golf balls regardless of whether the author recognizes the possibility or not.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6476176. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent's claims to golf balls of saturated polyurethanes, render obvious claims to the urethane itself.

Claims 1-9 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6506851. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent's claims to golf balls of saturated polyurethanes, render obvious claims to the urethane itself.

Claims 1-3,5-7 and 9-18 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,3,4,10-20 and 29-32 of copending Application No. 10-194057. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application also claims golf balls of saturated polyurethanes based on dimerates. The golf ball claims also render obvious claims to the urethane itself.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Buttner

DAVID J. BUTTNER
PRIMARY EXAMINER

12/20/04